

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte JAMES P. SCHAUBACH

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Appeal No. 1999-1987  
Application No. 08/400,129<sup>1</sup>

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ON BRIEF

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Before CALVERT, NASE, and BAHR, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 to 11, 17 to 22 and 25 to 27. Dependent

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<sup>1</sup> Application for patent filed March 6, 1995.

claim 24 has not been rejected.<sup>2</sup> Claims 12 to 16 and 23 have been canceled.

We AFFIRM-IN-PART and enter a new rejection pursuant to 37 CFR § 1.196(b).

#### BACKGROUND

The appellant's invention relates to a batting practice apparatus. An understanding of the invention can be derived from a reading of exemplary claim 1, a copy of which appears in the opinion section below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Albert 1963	3,086,775	Apr. 23,
Alexander 29, 1970	3,531,115	Sep.
Hutt et al. 1973	3,729,195	Apr. 24,

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<sup>2</sup> While the "Summary of Action" section of the final rejection (Paper No. 23, mailed December 24, 1996) states that claim 24 is rejected, no rejection of claim 24 is set forth therein or in the preceding nonfinal Office action (Paper No. 21, mailed March 21, 1996).

(Hutt)  
McGuckin et al. 5,165,682 Nov. 24,  
1992  
(McGuckin)

Claims 1 to 3, 7 and 8 stand rejected under 35 U.S.C. § 103 as being unpatentable over Alexander in view of Albert.

Claims 4 to 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Alexander and Albert as applied to claim 1 above, and further in view of Hutt.

Claims 9 to 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Alexander and Albert as applied to claim 1 above, and further in view of McGuckin.

Claims 17 to 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over McGuckin in view of Albert.

Claims 21, 22, 25 and 26 stand rejected under 35 U.S.C. § 103 as being unpatentable over Alexander in view of McGuckin and Albert.

Claim 27 stands rejected under 35 U.S.C. § 103 as being unpatentable over McGuckin in view of Alexander.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the nonfinal Office action (Paper No. 21, mailed March 21, 1996) and the answer (Paper No. 31, mailed December 21, 1998) for the examiner's complete reasoning in support of the rejections, and to the brief (Paper No. 27, filed April 7, 1998) for the appellant's arguments thereagainst.

#### OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Moreover, in evaluating such references it is proper to take into account not only the specific teachings of the references but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In re Preda, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968).

With this as background, we turn to the examiner's rejections of the claims on appeal.

**Claims 1 to 3**

We sustain the rejection of claims 1 to 3 under 35 U.S.C.  
§ 103.

Claim 1 reads as follows:

Batting practice apparatus for repeated, rotationally-swinging presentation of a simulated ball to a practicing batter, said apparatus comprising:

a. a flexible tether having proximal and distal ends;  
b. a substantially spherical, mechanical energy-absorbing mass affixed to said tether's distal end; and,  
c. an elongate, moderately flexible sleeve disposed in concentric relation with said tether, adjacent said tether's distal end.

Alexander discloses a batting practice device 10. As shown in Figures 1 and 2, the batting practice device 10 includes a ball 12, a line 14 made of light clothes line cord, and a swivel 16 fastened to a handle 18 by a pivot bolt 20. As shown in Figure 4, the ball is made of fairly dense sponge rubber and is secured to the line 14 by knots 42, 50. Alexander teaches (column, 3, lines 23-40) that sometimes it is desirable to use a ball having less resiliency and more weight than the sponge rubber ball 12. In that case,

Alexander discloses a heavier ball 12'. As shown in Figure 5, the heavier ball 12' is attached to the line 14 via two lengths 76, 78 of an elastic cord formed of elastic strands with a covering of cloth fabric braided suitably to permit expansion and contraction of the cord.

Albert discloses a baseball practice device. As shown in Figure 2, the baseball practice device includes a baseball 25, a length of linked chain 23, a rubber bumper 21 and a length of rubber tubing or hose 30 which extends over the lower portion of the chain 23 and engages at one end with the baseball 25. Albert teaches (column 1, lines 43-46, and column 2, lines 26-28) that the length of rubber tubing or hose 30 provides protection for the bat and eliminates whips in the chain which would otherwise occur when the ball is struck.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Alexander and claims 1 to 3, it is our opinion that the only difference is the limitation in claim 1 that the batting practice apparatus includes "an elongate, moderately flexible sleeve disposed in concentric relation with said tether, adjacent said tether's distal end."

In applying the above-noted test for obviousness with regard to this difference, we reach the conclusion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have provided the batting practice device of Alexander with a length of rubber tubing or hose extending over the lower portion of Alexander's line 14 and engaging at one end with the ball 12, 12' as suggested by the teachings of Albert so as to eliminate whips in the line 14 which would otherwise occur when the ball is struck.

Additionally, it is well settled that a disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the



epitome of obviousness." Jones v. Hardy, 727 F.2d 1524, 1529, 220 USPQ 1021, 1025 (Fed. Cir. 1984). See also In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 571 (CCPA 1982); In re Pearson, 494 F.2d 1399, 1402, 181 USPQ 641, 644 (CCPA 1974).

In this case, it is our view that claims 1 to 3, are anticipated by Albert under 35 U.S.C. § 102(b). In that regard, claim 1 reads on Albert as follows: Batting practice apparatus for repeated, rotationally-swinging presentation of a simulated ball to a practicing batter<sup>3</sup>, said apparatus

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<sup>3</sup> The statement of purpose or intended use of the invention set forth in the preamble is not a claim limitation since the appellant has defined a complete invention in the claim body. See Rowe v. Dror, 112 F.3d 473, 478, 42 USPQ2d 1550, 1553 (Fed. Cir. 1997), cited in Pitney Bowes Inc. v. Hewlett-Packard Co., 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165-66 (Fed. Cir. 1999); In re Sinex, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962). There is an extensive body of precedent on the question of whether a statement in a claim of purpose or intended use constitutes a limitation for purposes of patentability. See generally Kropa v. Robie, 187 F.2d 150, 155-59, 88 USPQ 478, 483-87 (CCPA 1951) and the authority cited therein, and cases compiled in 2 Chisum, Patents § 8.06[1][d] (1991). Such statements often, although not necessarily, appear in the claim's preamble. See In re Stencel, 828 F.2d 751, 754, 4 USPQ2d 1071, 1073 (Fed. Cir. 1987).

comprising: a. a flexible tether (i.e., Albert's chain 23) having proximal and distal ends; b. a substantially spherical, mechanical energy-absorbing mass (i.e., Albert's ball 25) affixed to said tether's distal end; and, c. an elongate, moderately flexible sleeve (i.e., Albert's rubber tubing or hose 30) disposed in concentric relation with said tether, adjacent said tether's distal end. The limitation of claim 2 reads on Albert as follows: said tether has means for being grasped at its proximal end (i.e., Albert's bumper 21). The limitation of claim 3 reads on Albert as follows: said mechanical energy-absorbing mass is a spherical, resilient ball (i.e., Albert's baseball 25).

With respect to claim 1, the appellant argues (brief, pp. 9-13) that there is no teaching, suggestion, incentive or motivation to combine the teachings of Alexander and Albert. We do not agree.

While there must be some teaching, reason, suggestion, or motivation to combine existing elements to produce the claimed device, it is not necessary that the cited references or prior

art specifically suggest making the combination (see B.F. Goodrich Co. v. Aircraft Braking Systems Corp., 72 F.3d 1577, 1583, 37 USPQ2d 1314, 1319 (Fed. Cir. 1996) and In re Nilssen, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988)) as the appellant would apparently have us believe. Rather, as set forth above, the test for obviousness is what the combined teachings of the references would have suggested to one of ordinary skill in the art. See In re Young, 927 F.2d 588, 591, 18 USPQ2d 1089, 1091 (Fed. Cir. 1991) and In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Thus, this argument by the appellant is not persuasive that any error in the determination regarding the obviousness of claim 1 has occurred. As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. See In re Dillon, 919 F.2d 688, 693, 16 USPQ2d 1897, 1901 (Fed. Cir. 1990)(en banc), cert. denied, 500 U.S. 904 (1991) and In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992). In this case, we have concluded that for the reasons set forth above, the combined teachings of Alexander and Albert do

provide the necessary teaching, reason, suggestion, and motivation to have combine their existing elements to produce the claimed invention.

Further with respect to claim 1, the appellant argues (brief, pp. 13-14) that Albert's rubber tubing or hose 30 is not a "moderately flexible" sleeve as recited in claim 1. We do not agree.

In view of the purpose of Albert's rubber tubing or hose 30 (i.e., to provide protection for the bat and to eliminate whips in the chain which would otherwise occur when the ball is struck), we reach the conclusion that the limitation "moderately flexible" is readable on Albert's rubber tubing or hose 30. In that regard, the phrase "moderately flexible" must be given its broadest reasonable meaning.<sup>4</sup> Since the

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<sup>4</sup> The Patent and Trademark Office (PTO) applies to the verbiage of the claims before it the broadest reasonable meaning of the words in their ordinary usage as they would be understood by one of ordinary skill in the art, taking into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the appellant's specification. In re Morris, 127 (continued...)

appellant's written description provides no enlightenment by way of definitions or otherwise as to the intended meaning of "moderately flexible," we must look at the standard dictionary meanings of those words. The American Heritage Dictionary, Second College Edition, (1982) defines (1) "flexible" as "Capable of being bent or flexed; pliable" and (2) "moderate" as "Within reasonable limits; not excessive or extreme." We find that Albert's rubber tubing or hose 30 is inherently a structure that is capable of being bent or flexed within reasonable limits. Thus, we conclude that the limitation "moderately flexible" is readable on Albert's rubber tubing or hose 30.

With respect to claims 2 and 3, the appellant argues (brief, p. 15) that these dependent claims have essentially been rejected for a lack of novelty under 35 U.S.C. § 102. We do not agree. While the examiner did state (nonfinal Office action, p. 2) that Alexander clearly shows the structure as

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<sup>4</sup>(...continued)  
F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997). See also In re Sneed, 710 F.2d 1544, 1548, 218 USPQ 385, 388 (Fed. Cir. 1983).

defined in claims 2 and 3, this statement was clearly meant to mean only that the additional limitations set forth in claims 2 and 3 are met by the teachings of Alexander. Thus, the subject matter of claims 2 and 3 are rendered obvious under 35 U.S.C. § 103 on the same basis as set forth above.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3 under 35 U.S.C. § 103 is affirmed.

**Claim 7**

We sustain the rejection of claim 7 under 35 U.S.C. § 103.

Claim 7 reads as follows:

The apparatus of Claim 1, wherein said tether comprises an inner core of a plurality of linearly resilient strands, and an outer linearly extendable, fabric sheath.

The appellant argues (brief, pp. 16-17) that the true tether in both of Alexander's disclosed embodiments is line 14 which is clearly nonresilient. We do not agree for the

following reason. In the Figure 5 embodiment of Alexander, the tether comprises both line 14 and the two portions 76, 78 of elastic cord. Since the elastic cord of Alexander is formed of elastic strands with a covering of cloth fabric braided suitably to permit expansion and contraction of the cord, it is our determination that the limitations of claim 7 read on the Figure 5 embodiment of Alexander.

For the reasons set forth above, the decision of the examiner to reject claim 7 under 35 U.S.C. § 103 is affirmed.

**Claim 8**

We sustain the rejection of claim 8 under 35 U.S.C. § 103.

Claim 8 reads as follows:

The apparatus of Claim 1, wherein said sleeve is sufficiently durable not to be damaged by a bat's impact and wherein said sleeve is further sufficiently flexible to yield when so hit and, at once, shape-retaining, to resist wrapping around a bat and to return immediately to a substantially linear configuration after such an impact.

The appellant argues (brief, pp. 17-19) that the limitations of claim 8 are not suggested or taught by Albert's rubber tubing or hose 30. We do not agree. In that regard, we find that Albert's rubber tubing or hose 30 is inherently a structure that is (1) sufficiently durable not to be damaged by a bat's impact, (2) sufficiently flexible to yield when so hit and, (3) shape-retaining to resist wrapping around a bat and to return immediately to a substantially linear configuration after such an impact. Thus, we conclude that the limitations of claim 8 are readable on Albert's rubber tubing or hose 30.

For the reasons set forth above, the decision of the examiner to reject claim 8 under 35 U.S.C. § 103 is affirmed.

**Claims 4 to 6**

We sustain the rejection of claims 4 to 6 under 35 U.S.C. § 103.



In addition to the teachings of Alexander and Albert, the examiner relies upon the additional teachings of Hutt in rejecting claims 4 to 6. Hutt's invention relates to the attachment of a line to a ball. Hutt teaches (column 1, lines 10-20) that

[t]here are many games and sporting apparatus requiring the attachment of a line, whether the line be a cord, a length of elastic, or the like. In most cases, the ball used is of the tennis ball type but it will be appreciated that the invention is intended to be extended to other suitable balls.

Previously, the attachment of the line to a ball suffered from many disadvantages, the tearing of the ball from the attachment being the most important. In addition, many a game was spoiled by the twisting of the line, which also caused premature breaking of the line.

As shown in the drawing, a hollow ball 10 (e.g., a tennis ball) is connected to a line 20. The ball has a hole 12 which snugly accommodates the raised portion 14 of an integral unit comprising a base 16 and the raised portion 14. An orifice 18 extends right through the base to receive the line 20 which also passes through a bullet-shaped element 22 and is knotted or otherwise anchored thereto. The other end of the line 20 is provided with a hook 24 or the like for attachment to a sporting apparatus or game.

Claim 4 reads as follows: "The apparatus of Claim 3, wherein said ball is hollow."

In applying the above-noted test for obviousness, we additionally conclude that it would have been further obvious at the time the invention was made to a person having ordinary skill in the art to have modified the ball in Alexander's device to be hollow as suggested and taught by Hutt to provide improved anchoring of the ball to the line.

The appellant argues (brief, pp. 19-21) that (1) Hutt is non-analogous art, and (2) there is no suggestion to combine the ball of Hutt with the apparatus of Alexander. We do not agree.

The test for non-analogous art is first whether the art is within the field of the inventor's endeavor and, if not, whether it is reasonably pertinent to the problem with which the inventor was involved. In re Wood, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979). A reference is reasonably pertinent if, even though it may be in a different field of

endeavor, it logically would have commended itself to an inventor's attention in considering his problem because of the matter with which it deals. In re Clay, 966 F.2d 656, 659, 23 USPQ2d 1058, 1061 (Fed. Cir. 1992). In the present instance, we are informed by the appellant's originally filed specification (p. 1) that the invention relates generally to training equipment for baseball and related games. Hutt's invention is directed to many games and sporting apparatus that require the attachment of a line, whether the line be a cord, a length of elastic, or the like, to a ball and thus falls into the former category of the Wood test. Moreover, since one problem with which the appellant's invention deals with is the connection of the tether with the ball, Hutt's invention logically would have commended itself to an artisan's attention in considering that problem. Thus, we conclude that Hutt is analogous art.

It is our conclusion that there is suggestion to combine the ball of Hutt with the apparatus of Alexander. In that regard, Hutt clearly teaches the advantages of connecting a tether line to a hollow ball and thus supplies the necessary

motivation for modifying Alexander.<sup>5</sup> In this case, we have concluded that for the reasons set forth above, the combined teachings of Alexander, Albert and Hutt do provide the necessary teaching, reason, suggestion, and motivation to have combined their existing elements to produce the claimed invention.

For the reasons set forth above, the decision of the examiner to reject claim 4 under 35 U.S.C. § 103 is affirmed.

The appellant has grouped claims 4 to 6 as standing or falling together.<sup>6</sup> Thereby, in accordance with 37 CFR § 1.192(c)(7), claims 5 and 6 fall with claim 4. Thus, it follows that the decision of the examiner to reject claims 5 and 6 under 35 U.S.C. § 103 is also affirmed.

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<sup>5</sup> As noted previously, the law does not require that the references be combined for the reasons contemplated by the inventor.

<sup>6</sup> See page 7 of the appellant's brief.

**Claims 9 to 11**

We sustain the rejection of claims 9 to 11 under 35  
U.S.C.  
§ 103.

In addition to the teachings of Alexander and Albert, the examiner relies upon the additional teachings of McGuckin in rejecting claims 9 to 11. McGuckin's invention relates generally to reflex skill development devices for use in athletic games, particularly baseball and methods for using such devices. In particular, Figure 1 is a pictorial view illustrating two athletes using the reflex skill device of McGuckin in a batting practice function. As shown in Figure 3, the reflex skill development device comprises a hollow ball 40 attached by a resilient tether 17 to a loop, handle or enlargement of the tether 19. Ball 40 comprises a resilient cover 58 with a plurality of perforations 56 therethrough. McGuckin teaches that the tether 17 is preferably constructed in two parts of two dissimilar materials. A first part 38 (also called a short tether) of short stretchable material is attached at one end to the ball 40 through perforations 56 and

then attached at a second end through a swivel arrangement 27 to a second part 21 of the tether. The short tether 38 is most preferably of a stretchable material forgiving enough to allow a stretch ratio in the range of about 3:1 to about 4:1. Additionally, in the batting function as illustrated in Figure 1, should the batter miss the ball with the bat and strike the short tether, the tether will stretch during its wrapping around the bat such that injury to the pitcher will be prevented. An extended rubber tubing (e.g., surgical tubing) with an internal diameter of 1/16 inches and an external diameter of 1/4 to 5/16 inches has been found by McGuckin to perform adequately. The short tether may be covered by a braided material, however the weave of such braided material should be such as to allow for the required stretch capability. The second part 21 of the tether line (also called an adjusting line) is preferably of a smaller light gauge material, most preferably multibraided nylon. The adjusting line 21 is in turn attached to the handle 19.

*Claim 9*

Claim 9 reads as follows: "The apparatus of Claim 1, further including means within the length of said tether for preventing twisting."

In applying the above-noted test for obviousness, we additionally conclude that it would have been further obvious at the time the invention was made to a person having ordinary skill in the art to have modified Alexander's line 14 to include a swivel arrangement therein as suggested and taught by McGuckin's swivel arrangement 27 in line 14 to provide the self evident advantage thereof. Moreover, in applying the above-noted test for obviousness, we additionally conclude that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have provided McGuckin's device with a length of rubber tubing or hose extending over the short tether portion 38 and engaging at one end with the ball 40 as suggested by the teachings of Albert so as to eliminate whips in the short tether portion 38 which would otherwise occur when the ball is struck.

The appellant argues (brief, pp. 24-25) that it would not have been obvious to have provided McGuckin's swivel arrangement 27 in Alexander's line 14 since Alexander already includes a swivel 16. We do not agree for the following reasons. First, the McGuckin's swivel arrangement 27 is not duplicative of Alexander's swivel 16 since each would permit swiveling about different axes. Second, McGuckin's swivel arrangement 27 is a known alternative to Alexander's swivel 16 and thus it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have replaced Alexander's swivel 16 with McGuckin's swivel arrangement 27.

For the reasons set forth above, the decision of the examiner to reject claim 9 under 35 U.S.C. § 103 is affirmed.

*Claim 11*

The appellant has grouped claims 9 and 11 as standing or falling together.<sup>7</sup> Thereby, in accordance with 37 CFR

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<sup>7</sup> See page 7 of the appellant's brief.



§ 1.192(c)(7), claim 11 falls with claim 9. Thus, it follows that the decision of the examiner to reject claim 11 under 35 U.S.C. § 103 is also affirmed.

*Claim 10*

Claim 10 reads as follows: "The apparatus of Claim 1, wherein said tether is further comprised of a substantially nonresilient proximal portion having proximal and distal ends, and a linearly resilient distal portion having proximal and distal ends."

In our view, these additional limitations read on the Figure 5 embodiment of Alexander wherein the tether comprises both line 14 (i.e., a substantially nonresilient proximal portion having proximal and distal ends) and the two portions 76, 78 of elastic cord (i.e., a linearly resilient distal portion having proximal and distal ends). Moreover, in applying the above-noted test for obviousness, we additionally conclude that it would have been further obvious at the time the invention was made to a person having ordinary skill in the art to have modified Alexander's line 14 to include both a

short tether, a swivel arrangement and an adjusting line as suggested and taught by McGuckin's tether 17 having a short tether 38, a swivel arrangement 27 and an adjusting line 21 to provide the self evident advantage thereof.

The appellant argues (brief, pp. 21-23) that (1) there is no incentive or suggestion to have combined the teachings of McGuckin with Alexander, and (2) the introduction of McGuckin's short tether 38 into Alexander's tether would be superfluous. We do not agree for the following reasons. First, McGuckin's two part tether with swivel arrangement 27 is a known alternative to Alexander's tether and thus it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have replaced Alexander's tether with McGuckin's tether 17. Second, McGuckin's tether 17 would not be superfluous in the Alexander's Figure 4 embodiment. Lastly, the additional limitations of claim 10 are readable on the Figure 5 embodiment of Alexander as set forth above.

For the reasons set forth above, the decision of the examiner to reject claim 10 under 35 U.S.C. § 103 is affirmed.

**Claims 17 to 22**

We will not sustain the rejection of claims 17 to 22 under 35 U.S.C. § 103.

Claims 17 to 22 include the limitation that the tether "slides freely" within a moderately flexible sleeve.

Clearly this limitation is not met by any of the applied prior art. Specifically, there is no disclosure in Albert that his chain 23 "slides freely" within the rubber tubing or hose 30.

Since all the limitations of claims 17 to 22 are not suggested by the applied prior art for the reasons set forth above, the decision of the examiner to reject claims 17 to 22 under 35 U.S.C. § 103 is reversed.

**Claim 25**

We sustain the rejection of claim 25 under 35 U.S.C. §  
103.

Claim 25 reads as follows:

Batting practice apparatus for repeated, rotationally-swinging presentation of a simulated ball to a practicing batter, said apparatus comprising:

a. a flexible tether having proximal and distal ends, said tether being comprised of a substantially nonresilient proximal portion and a linearly resilient distal portion;

b. a substantially spherical, mechanical energy-absorbing mass affixed to said tether's distal end; and,

c. a sleeve disposed in concentric relation with said tether, and adjacent said tether's distal end, wherein said sleeve is sufficiently durable not to be damaged by a bat's impact, and wherein said sleeve is further sufficiently flexible to yield when so hit and, at once, shape-retaining, to resist wrapping around a bat and to return immediately to a substantially linear configuration after said bat's impact.

In applying the above-noted test for obviousness with respect to claim 25, we reach the conclusion that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have (1) provided the batting practice device of Alexander with a length of rubber tubing or hose extending over the lower portion of

Alexander's line 14 and engaging at one end with the ball 12, 12' as suggested by the teachings of Albert so as to eliminate whips in the line 14 which would otherwise occur when the ball is struck, and (2) modified Alexander's line 14 to include both a short tether, a swivel arrangement and an adjusting line as suggested and taught by McGuckin's tether 17 having a short tether 38, a swivel arrangement 27 and an adjusting line 21 to provide the self evident advantage thereof. Moreover, in applying the test for obviousness, we additionally conclude that it would have been obvious at the time the invention was made to a person having ordinary skill in the art to have provided McGuckin's device with a length of rubber tubing or hose extending over the short tether portion 38 and engaging at one end with the ball 40 as suggested by the teachings of Albert so as to eliminate whips in the short tether portion 38 which would otherwise occur when the ball is struck.

The arguments set forth by the appellant in the brief (pp. 36-38) are unpersuasive since the applied prior art is suggestive of the claimed invention for the reasons set forth above and in our previous discussions of claims 1, 8 and 10.

Accordingly, the decision of the examiner to reject claim 25 under 35 U.S.C. § 103 is affirmed.

**Claim 26**

We now turn to the rejection of claim 26. However, for reasons stated infra in our new rejection under the second paragraph of Section 112 entered under the provisions of 37 CFR 1.196(b), no reasonably definite meaning can be ascribed to certain language appearing in the claim. As the court in In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) stated:

[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art. If no reasonably definite meaning can be ascribed to certain terms in the claim, the subject matter does not become obvious --the claim becomes indefinite.

In comparing the claimed subject matter with the applied prior art, it is apparent to us that considerable speculations and assumptions are necessary in order to determine what in fact is being claimed. Since a rejection based on prior art cannot be based on speculations and assumptions, see In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962), we are constrained to reverse, pro forma, the examiner's rejection of claim 26 under

35 U.S.C. § 103. We hasten to add that this is a procedural reversal rather than one based upon the merits of the section 103 rejection.

**Claim 27**

We sustain the rejection of claim 27 under 35 U.S.C. § 103.

Claim 27 reads as follows:

Batting practice apparatus for repeated, rotationally-swinging presentation of a simulated ball to a practicing batter, said apparatus comprising:

a. a flexible tether having proximal and distal ends, said tether being comprised of a substantially nonresilient proximal portion and a linearly resilient distal portion, wherein said linearly resilient portion of said tether comprises an inner core of a plurality of linearly resilient strands, and an outer linearly extendable, fabric sheath; and,

b. a substantially spherical, mechanical energy-absorbing mass affixed to said tether's distal end.

In applying the above-noted test for obviousness with respect to claim 27, we reach the conclusion that it would have been obvious at the time the invention was made to a



person having ordinary skill in the art to have modified McGuckin's device so that the connection between his tether and ball is made in the manner suggested and taught by Alexander's Figure 5 embodiment. Moreover, it is our view that claim 27 is obvious from Alexander alone since claim 27 is anticipated by Alexander under 35 U.S.C. § 102(b).<sup>8</sup> In that regard, claim 27 reads on Alexander as follows: Batting practice apparatus for repeated, rotationally-swinging presentation of a simulated ball to a

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<sup>8</sup> A disclosure that anticipates under 35 U.S.C. § 102 also renders the claim unpatentable under 35 U.S.C. § 103, for "anticipation is the epitome of obviousness." See page 7, *supra*.

practicing batter, said apparatus comprising: a. a flexible tether (i.e., Alexander's line 14 and two portions 76, 78 of elastic cord) having proximal and distal ends, said tether being comprised of a substantially nonresilient proximal portion (i.e., Alexander's line 14) and a linearly resilient distal portion (i.e., Alexander's two portions 76, 78 of elastic cord), wherein said linearly resilient portion of said tether comprises an inner core of a plurality of linearly resilient strands (i.e., Alexander's two portions 76, 78 of elastic cord include elastic strands), and an outer linearly extendable, fabric sheath (i.e., Alexander's two portions 76, 78 of elastic cord include a covering of cloth fabric over the elastic strands); and, b. a substantially spherical, mechanical energy-absorbing mass (i.e., Alexander's ball 12') affixed to said tether's distal end.

The arguments set forth by the appellant in the brief (pp. 40-42) are unpersuasive since the applied prior art is suggestive of the claimed invention for the reasons set forth above and in our previous discussion of claim 7. Accordingly,

the decision of the examiner to reject claim 27 under 35 U.S.C. § 103 is affirmed.

New ground of rejection

Under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection.

Claims 24 and 26 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the appellant regards as the invention.

Claims are considered to be definite, as required by the second paragraph of 35 U.S.C. § 112, when they define the metes and bounds of a claimed invention with a reasonable degree of precision and particularity. See In re Venezia, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976).

In this case, we are unable to determine the metes and bounds of claims 24 and 26 with a reasonable degree of precision and particularity for the following reasons. With

respect to claim 24, we consider this claim to be indefinite since it depends from canceled claim 23. Thus, it is unclear to us which, if any, limitations are being incorporated by reference. With respect to claim 26, we consider this claim to be indefinite since there is no antecedent basis for "said twisting preventing means." Thus, it is unclear to us if the appellant intended to include a twisting preventing means in the claimed combination or intended to refer to another element (e.g., nonresilient tether portion).

#### CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 11, 25 and 27 under 35 U.S.C. § 103 is affirmed; the decision of the examiner to reject claims 17 to 22 and 26 under 35 U.S.C. § 103 is reversed; and a new rejection of claims 24 and 26 under 35 U.S.C. § 112, second paragraph, has been added pursuant to provisions of 37 CFR § 1.196(b).

In addition to affirming the examiner's rejection of one or more claims, this decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b)

provides, "[a] new ground of rejection shall not be considered final for purposes of judicial review."

Regarding any affirmed rejection, 37 CFR § 1.197(b) provides:

(b) Appellant may file a single request for rehearing within two months from the date of the original decision . . . .

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (37 CFR § 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .

(2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

Should the appellant elect to prosecute further before the Primary Examiner pursuant to 37 CFR § 1.196(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§

141 or 145 with respect to the affirmed rejection, the effective date of the affirmance is deferred until conclusion of the prosecution before the examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If the appellant elects prosecution before the examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART; 37 CFR § 1.196(b)

IAN A. CALVERT	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
JEFFREY V. NASE	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JENNIFER D. BAHR	)	
Administrative Patent Judge	)	

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APPEAL NO. 1999-1987 - JUDGE NASE  
APPLICATION NO. 08/400,129

APJ NASE

APJ CALVERT

APJ BAHR

DECISION: **AFFIRMED-IN-PART;**  
**37 CFR § 1.196(b)**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 02 Nov 99

**FINAL TYPED:**